

IN THE DRAWINGS

Please amend FIG. 18 so that FIG. 18 corresponds to the detailed specification. A redline copy of the proposed amendment to FIG. 18 is enclosed along with a clean copy of FIG. 18 as amended.

REMARKS

In response to the Office Action mailed February 2, 2006, each one of the cited references has been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file in the above-identified application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

In order to render the claims more clear and definite and to emphasize the patentable novelty thereof, claims 1, 21-24, and 32 has been amended.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested.

Response to Amendment

In the Office Action dated February 2, 2006, the examiner has stated that claims 1, 5, 13-18, and 21-24, 26-29 and 32-35 are pending in this case. In this regard, the examiner has stated that claims 4, 6-12, 19 and 20 were previously cancelled in an amendment filed on March 18, 2005 and then in the amendment of claims 11-27-05 the claims were withdrawn. For clarification therefore the following is provided:

1. The present application was filed on October 28, 2003 as a Division of U.S. Serial No. 09/910,641, filed on July 20, 2001, which claims benefit of 60/220,357, filed July 24, 2000.
2. As a first action, the examiner, on December 9, 2004, imposed an election/restriction requirement. Applicant requested reconsideration of the restriction/election requirement on December 18, 2004.
3. On February 24, 2005, in response to the request for reconsideration, the examiner issued an new office action, withdrawing claims 4, 19-20 from further consideration, and then examined the application on its merits.

Applicant responded to the office action of February 24, 2005, on March 18, 2005, cancelling claims 2-4, 6-12, and 19-20.

4. On June 14, 2005, the examiner issued a Notice of Non-Compliant Amendment (37CFR 1.121). Applicant responded by filing a compliant amendment on June 17, 2005 cancelling claims 2-3, 6-12, and further indicating that claims 4 and 19-20 had been withdrawn.
5. On September 7, 2005, the examiner issued a final office action, indicating that claims 1, 4-5 and 13-31 were pending in the case, but then further indicated that claims 4, 19-20, 22-24, 26, and 28-31 had been withdrawn from further consideration. In this regard, the examiner imposed a further election/restriction requirement stating that claims 22-24, 26, and 28-31 were directed to an invention that was independent or distinct from the invention originally claimed. The examiner further withdrew claims 22-24, 26 and 28-31 without allowing applicant to traverse the election/restriction requirement stating that the invention as earlier claimed was constructively elected by "original presentation for prosecution on the merits".
6. On November 7, 2005, applicant filed an Amendment After Final Rejection, which was not entered because of applicant's specific request in the RCE amendment that was filed on November 27, 2005.
7. In the RCE Amendment filed on November 27, 2005, applicant indicated that claims 2-3, and 6-12 were cancelled and that claims 4 and 19-20 were withdrawn. Applicant at this time traversed the election/restriction requirement imposed by the examiner relative to claims 22-24, 26, and 28-29 because each of the claims were dependent claims which depended from claim 1, which the examiner had stated was a generic claim in the Office action dated December 9, 2004. In this regard, attorney for applicant requested that the

examiner reconsider the petition that asserted that claims 22-24, 26, and 28-29 were not directed to a non-elected invention. Attorney for applicant did not traverse relative to claims 30-31, and indicated that these claims were withdrawn since they did not depend from the generic claim 1.

8. In the present office action dated February 2, 2006, the examiner indicated that the RCE amendment of November 27, 2005 had been entered and that the finality of the previous office action had been withdrawn. In the present office action, of February 2, 2006, the examiner did not address the applicant's argument relative to claims 22-24, 26, and 28-29 as not being directed to a non-elected invention, but instead, merely stated that those claims are pending and then stated that the status of claims 4, 6-12, and 19-20 was unclear in view of the amendment filed on November 27, 2005.
9. Attorney for applicant can not understand what is not clear relative to claims 4, 6-12, and 19-20. In this regard, in the RCE amendment of November 27, 2005, claims 4 and 19-20 are indicated as being withdrawn, which has been true since they were withdrawn by the examiner in the office action of February 24, 2005. With respect to claims 6-12, in the RCE amendment of November 27, 2005, these claims are indicated as being cancelled, not withdrawn as indicated by the examiner, which also has been the case since applicant's response of June 17, 2005. Since these claims appear to be properly labeled, attorney for applicant will therefore require a clearer explanation as to how more properly label these claims to avoid a notice of non-compliance.

Specification Corrections

1. Priority

The examiner has noted that the application contains subject matter that was disclosed in earlier prior applications 09/910,641 and 10/454,236 filed on July 20,

2001 and June 6, 2003 respectively. In making this notation the examiner has stated that if applicant intends to rely on the filing date of a prior application under 35 U.S.C. § 119(e), 120, 121, or 365(c) that a reference to the prior application must be inserted as a first sentence(s) of the present specification or in an application data sheet as provided in 37 CFR 1.76. Attorney for applicant acknowledges this requirement and accordingly has amended the specification to include reference to the '641 application which was recognized by the Office as shown by its inclusion on the first filing receipt issued in this matter. As this prior application has been recognized by the Office within the time period set forth in 37 CFR 1.78(a), there is no need for a petition under 37 CFR 1.78 (a) nor is there any surcharge required under 37 CFR 1.17(t). Attorney for applicant respectfully requests the examiner to allow the entry of the change in paragraph [0001] as proposed.

2. New Matter

A. Paragraphs [0001] and [0002]

The examiner has further objected to the specification under 35 U.S. C. 132(a) on the assertion that the amendments filed on March 18, 2005 and June 17, 2005 introduce new matter into the disclosure. More specifically the examiner has stated: "[T]he added material which is not supported by the original disclosure is as follows: the related applications sections from the originally filed specification is different from that of the 03/18/05 and 06/17/05 specifications."

The March 18, 2005 Amendment was never entered by the Office and therefore there is no need to address the specification amendment made in that response.

With respect to the June 17, 2005 Amendment, amendments to paragraphs [0001] and [0002] to correct an abbreviation issues and a typographical error respectively were made. Neither of these amendments to the specification introduced new matter although the application sections from the originally filed specification is different from the changes to these paragraphs. Accordingly, the objection made to these sections by the examiner would be improper.

B. Paragraph [0045]

Also with respect to the June 17, 2005 Amendment, applicant amended paragraph [0045] by adding a concluding sentence to further describe the thistle cloth 66 as follows: *The thistle cloth 66, a layer of either hooks and piles, is secured to the bottom surface 63 for providing it with a decorated textured finish.* Does this sentence constitute new matter under 35 U.S.C. 132(a)?

New matter under 35 U.S.C. 132(a) is anything that is added to, or from, the claim, drawings or specification, that was neither shown nor suggested in the original application (see 35 U.S.C. 132 and 37 CFR § 1.121). Based on the foregoing if that which was added is suggested or shown in the original application, it should not constitute new matter. Accordingly, the objection made to this paragraph by the examiner would be improper.

a. *The thistle cloth 66is secured to the bottom surface 63....*

Turning now to the “the thistle cloth 66”. The thistle cloth 66 is clearly shown in FIG. 14 and is depicted as a bottom textured surface relative to the pad 60. The specification as originally filed specifies at page 7, lines 6-7: “Bottom surfaces 63 of pad 60 is at least partially covered with a layer of thistle cloth.” Moreover, the specification at page 7, lines 21-22 provides: “[T]histle cloth 83 at least partially covers inner surface 84 and engages complimentary thistle cloth 66 on bottom surface 63 of the pad”. Based on the foregoing, the added text is clearly supported in the original application and does not therefore constitute new matter.

b.. *The thistle cloth 66, ... secured to the bottom surface 63 for providing it with a decorated textured finish.*

Next, attorney for applicant addresses “a decorated textured finish”. Claim 2 of the application as originally filed, which forms part of the original disclosure, recited the step of “providing decoration selected from at least one of the group comprising color, pattern, graphic design, text, advertising, relief design, **and texture**. (Emphasis added).

Based on the foregoing, the added text ***for providing it with a decorated textured finish*** is also shown in the original application and therefore does not therefore constitute new matter.

c. The thistle cloth 66, a layer of either hooks and piles

Finally, attorney for applicant addresses “a layer of either hooks or piles”. The Office discourages applicants from utilizing trade names and trademarks, such as Velcro® in disclosures. Accordingly in the present application, the word “thistle cloth” was utilized as opposed to “Velcro®”. The word “thistle cloth” is well known by those skilled in the art to reference a material having a hook type fastening surface composed of hooks and piles. See U.S. Patent 4,615,046 for example. Moreover, the specification at page 7, lines 21-22 provides: “[T]histle cloth 83 at least partially covers inner surface 84 and engages complimentary thistle cloth 66 on bottom surface 63 of the pad”. The word “complimentary” in this case suggests that the thistle cloth 66 can be composed of either hooks or piles” to facilitate engagement with a complimentary surface of either hooks or piles on the thistle cloth 83. Based on the following, the added text “*a layer of either hooks and piles*” is clearly suggested by a common meaning as understood by those skilled in the art, but it is also clearly shown in the drawings relative to FIGS. 14, 15, 16, and 17.

In summary then, the added sentence at the end of paragraph [0045] does not constitute new matter under 35 U.S.C. 132(a) and attorney for applicant respectfully requests that the examiner withdraw this rejection.

C. Claim 21

The examiner has objected to the specification as failing to provide a proper antecedent basis for the claimed subject matter under 37 CFR 1.75(d)(1) and MPEP § 608.01(o). In this regard, the examiner has stated the “Correction of the following is required: in claim 21, there is no support in the disclosure for “non-skin irritating adhesive”. Attorney for applicant respectfully disagrees on the following ground.

The terms “non-skin irritating” clearly find support in the specification at

paragraph [0030] which provides in pertinent part: "It is desirable that the adhesive selected be waterproof as well as **compatible with skin** on the bottom of the foot." Also in paragraph [0050] it provides in pertinent part: "Of the available adhesives, the adhesive used by Johnson & Johnson in its hydrocolloid adhesive Band-Aid RTM. Callus Relief product featuring Compeed, RTM, Moisture Seal™ Technology and as disclosed in U.S. Pat No. 4,367,732; U.S. Pat Nos. 4,867,748; and 5,643,187 is among the adhesives presently preferred," which patents specifically indicate that the adhesive be "**skin-friendly**". Attorney for applicant is not aware of any requirement under U.S. patent law that would require the specification to utilize the exact words found in the claims when such words are clearly suggested or disclosed in the specification. In this regard, the words "skin compatible" and/or "skin-friendly" clearly suggests that the adhesive be "non skin irritating". Based on the foregoing, attorney for applicant respectfully requests that the examiner withdraw the objection as noted.

D. Claim 23

The examiner has objected to the specification as failing to provide a proper antecedent basis for the claimed subject matter under 37 CFR

1.75(d)(1) and MPEP § 608.01(o). In this regard, the examiner has stated the "Correction of the following is required: in claim 23, there is no support in the disclosure for "reusable adhesive means is a layered sweat barrier". Responsive to this objection, attorney for applicant has amended claim 23 to recite a waterproof barrier, which is fully supported in the original disclosure as filed. It should also be noted that in rejecting claim 23 under 35 U.S.C. 103 (a) in paragraph 21 of the Office Action dated February 2, 2006, the examiner has admitted that "a waterproof adhesive layer would also inherently be a sweat barrier"..

Although the examiner has admitted that a waterproof adhesive layer would inherently be a sweat barrier, applicant has nevertheless amended claim 23 by deleting the phrase "layered sweat barrier" and has substituted in its place and stead "said waterproof barrier". This amendment to claim 23 has been made to make claim 23

consistent with the amendment to claim 1 and is not to be construed as applicant conceding that the specification and drawings fail to support “a layered sweat barrier”.

Rejections

Rejections Under 35 USC §112 First Paragraph

A. Claim 1

Claim 1 has been rejected under 35 USC §112 first paragraph by the examiner on the grounds that the claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor at the time the application was filed, had possession of the claimed invention. In this regard, the examiner has stated that there is no support for the hooks or piles providing the pad with a decorated textured finish. Attorney for applicant respectfully disagrees and refers the examiner to the earlier arguments made relative to “new matter” made with respect to paragraph [0045]. Based on such arguments, attorney for applicant respectfully requests that the examiner withdraw this rejection.

Attorney for applicant would further argue that the **MPEP §608.01(o) makes it clear that an applicant is not limited to the nomenclature used in the application as filed.** In this regard, an applicant is encouraged to make appropriate amendments to the specification whenever the nomenclature is departed from by amendment of the claims so as to have clear support or antecedent basis in the specification for the new terms appearing in the claims. Accordingly, in order to make nomenclature utilized in the specification consistent with the nomenclature utilized in Claim 1, applicant previously amended paragraph [0045] of the specification by adding the following sentence, which based on the above, **does not constitute new matter.**

“The thistle cloth 66, a layer of either hooks and piles, is secured to the bottom surface 63 for providing it with a decorated textured finish.”

B. Claim 16

Claim 16 has been rejected under 35 USC §112 first paragraph by the examiner on the grounds that the claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor at the time the application was filed had possession of the claimed invention. In this regard, the examiner has stated that there is no support for the attachment engaging surface includes decorative indicia. Attorney for applicant respectfully disagrees and refers the examiner to the earlier arguments made relative to “new matter” relative to paragraph [0045], and specifically to the claim language of claim 2 as originally filed. In this case, the language “providing decoration selected from at least one of the group comprising color, pattern, graphic design, text, advertising , relief design and texture” clearly supports “wherein said attachment engaging surface includes decorative indicia selected from an indicia group consisting of color, patterns, messages, trademarks, and advertisements”, recited in claim 16. Based on the foregoing, attorney for applicant respectfully requests that the examiner withdraw this rejection.

C. Claim 24

Claim 24 has been rejected under 35 USC §112 first paragraph by the examiner on the grounds that the claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor at the time the application was filed, had possession of the claimed invention. In this regard, the examiner has stated that there is no support for “the layered sweat barrier being a strip of polyurethane tape with two layers waterproof adhesive and another layer of polyurethane tape with a reusable adhesive layer.” Attorney for applicant respectfully disagrees on the following grounds:

First, referring to FIG. 18 of the specification and the specification at paragraph 0028 which provides, “a two-sided acrylic pressure sensitive transfer tape 17 on the top surface 12, and a layer of MSX 5527 arcylate adhesive 14 (a polyurethane backing with

acrylate adhesive may be obtained from 3M Healthcare as MSX5527 acrylate polyurethane 1.2 mil tape), and a peel sheet 18 protecting the adhesive until ready to use.” In addition, at paragraph 0032, it provides, “the adhesive selected should be of sufficient strength to hold pad 10 onto the bottom of foot 1...It is desirable that the adhesive selected be waterproof as well as compatible with the skin of the bottom of the foot.

Finally with reference to FIG. 18 four distinct and separate elements can be seen in the following order: a pad (10) having a bottom surface (13) and a top surface (12); a transfer tape (17) composed of a polyurethane backing sandwiched between two layers of pressure sensitive adhesive; a polyurethane backing supporting an acrylate adhesive (14); and a peel sheet (18).

In summary then, both the drawings and the specification disclose a waterproof backing (14) [sweat being a form of liquid water discharged from the body] and a waterproof adhesive in the form of a two-sided pressure sensitive transfer tape (17) on the top surface (12) of the pad (10).

Notwithstanding the foregoing, applicant has amended claim 24 by deleting the phrase “layered sweat barrier” and has substituted in its place and stead “wherein said pair of flexible backings having different types of adhesives disposed thereon blocks sweat and includes”. This amendment to claim 24 has been made to make claim 24 consistent with the amendment to claim 23 and is not to be construed as applicant conceding that the specification and drawings fail to support “a layered sweat barrier”.

Based on the foregoing, applicant respectfully requests that the rejection under 35 USC § 112 first paragraph be withdrawn with respect to claim 24.

D. Claim 26

Claim 26 has been rejected under 35 USC §112 first paragraph by the examiner on the grounds that the claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor at the time the application was filed, had possession of the claimed invention. In this regard, the examiner has stated that there is no support for “a hard shell pre-formed cupped pad having a predefined shape for protecting a body part selected from a group consisting of at least one of toes, knees, elbows, and animal pads”. Attorney for applicant respectfully disagrees on the following grounds:

First, the specification provides in paragraph [0041] “pad 10 is shaped and sized to be applied to the feet of children and pets.”

Secondly, the specification in paragraph [0044] provides, “Yet another embodiment of the invention...includes pad 60 and one of the protective sheets shown in FIGS. 15, 16 or 17. “

Thirdly, paragraph [0049] provides,”Protective shells 70, 80, and 90 [shown in FIGS. 15, 16, and 17] can be made in a variety of sizes to fit differently sized adults and children.

Fourthly, in paragraph [0002] the specification provides that “Pads of animal feet may also benefit”.

Fifthly, in paragraph [0036] the specification provides, “The embodiments of the invention in FIGS. 5, 6, 9 and 10 may be worn with or without toe pieces 33....”

Finally, claim 4 as originally filed recited: “The invention of claim 1 further comprising pre-formed, cupped pads for at least one **of toes**, knees, elbows, and **animal pads**.”

In summary then, since the claims as originally filed form part of the original disclosure, and since the specification specifically recites that the pads are for use by adults, children and animals, there is support for “the hard shell pre-formed cupped pad being selected for the toes or animal pads” as rejected by the examiner. Based on the foregoing, attorney for applicant respectfully request that the examiner withdraw this rejection.

E. Claim 27

Claim 27 has been rejected under 35 USC §112 first paragraph by the examiner on the grounds that the claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor at the time the application was filed, had possession of the claimed invention. In this regard, the examiner has stated that there is no support for “hooks or piles provided a decoration”. Attorney for applicant respectfully disagrees and refers the examiner to the earlier arguments made relative to “new matter” relative to paragraph [0045], and specifically to the claim language of claim 2 as originally filed. In this case, the claim language recited, “providing decoration selected from at least one of the group comprising color, pattern, graphic design, text, advertising, relief design and texture”, which language clearly supports “wherein said layer of hooks or piles provides decoration selected from at least one decoration group comprising: color, pattern, graphic design, text, advertising, and relief design”, recited in claim 27, since decoration can be selected from texture. Based on the foregoing, attorney for applicant respectfully requests that the examiner withdraw this rejection.

F. Claim 28

Claim 28 has been rejected under 35 USC §112 first paragraph by the examiner on the grounds that the claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor at the time the application was filed, had possession of the claimed invention. In this regard, the examiner has stated that there is no support for “the hard shell pre-formed pad providing decoration to the user’s selected body part”. Attorney for applicant respectfully disagrees based on the following grounds: The specification in paragraph [0039] for example, among other places in the specification makes clear that the invention is for both protection and decoration. More specifically paragraph [0039] provides in pertinent part the following: “When used...pad 10 can also be decorated with

color, patterns, messages, trademarks and advertisements.” The operative word in this disclosure is “decorated” which provides support for “the hard shell pre-formed pad providing decoration to the user’s selected body part”. Based on the foregoing, attorney for applicant respectfully requests that the examiner withdraw this rejection.

G. Claim 29

Claim 29 has been rejected under 35 USC §112 first paragraph by the examiner on the grounds that the claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor at the time the application was filed, had possession of the claimed invention. In this regard, the examiner has stated that there is no support for “the hooks and piles having decoration consisting of color, pattern, graphic design, text, advertising and relief design”. Attorney for applicant respectfully disagrees based on the following grounds: Paragraph [0039] provides that the pad... can be decorated with color patterns, messages, trademarks, or advertisement”. Paragraph [0040] provides that the pad can be provided with a layer of thistle cloth”, which clearly suggests that the thistle cloth can be decorated with color patterns, messages, trademarks or advertisements. Based upon the earlier arguments that those skilled in the art clearly understand that thistle clothe is comprised of material with hooks and piles, there is full disclosure for “the hooks and piles having decoration consisting of color, pattern, graphic design, text, advertising and relief design”. Based on the foregoing attorney for applicant respectfully requests that the examiner withdraw this rejection.

H. Claim 32

Claim 32 has been rejected under 35 USC §112 first paragraph by the examiner on the grounds that the claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one

skilled in the art that the inventor at the time the application was filed, had possession of the claimed invention. In this regard, the examiner has stated that there is no support for “the layer of thistle cloth providing the pad with a decorated textured finish”. Attorney for applicant respectfully disagrees and incorporates herein the same arguments made in this section relative to claims 1, 16, 27, and 29 respectively. Based on the foregoing, attorney for applicant respectfully requests that the examiner withdraw this rejection.

I. Claim 34

Claim 34 has been rejected under 35 USC §112 first paragraph by the examiner on the grounds that the claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor at the time the application was filed, had possession of the claimed invention. In this regard, the examiner has stated that there is no support for “the thistle cloth providing the pad with a decorated textured finish”. Attorney for applicant respectfully disagrees under the same rationale as set forth earlier relative to claim 32.

Double Patenting Rejection

A. U.S. Patent Application 09/910,410

Claims 1,5, 13-18, 21, 27, and 32-35 have been provisionally rejected on the judicially created doctrine of obvious double patenting over claims 21, 22, 23, 27, 29, and 32 of co pending Application Serial No.: 09/910,641 in view of Hattori (U.S. Patent 4,553,550).

U. S. Patent Application 09/910,641 hereinafter the **‘641 application**, discloses a novelty fashion wear item comprised of a flexible pad having an upper and a lower surface with a non-slip texture where the upper surface is coated with an adhesive material for removably securing the pad to a contoured surface area of a body part and

where the upper surface is coated with an adhesive material for removably securing the pad to a contoured surface area of a body part and the lower surface is provided with indicia to decorate the contoured surface area of the body part covered by the pad.

Hattori, U.S. 4,553,550 hereinafter the **Hattori reference**, discloses a personal wearing article comprised of a main body having loops and hooks on the inner surface thereof, a retainer having hooks or loops on the front side thereof engagable with the loops or hooks on the main body, and a pressure sensitive adhesive agent layer provided on the back side of the retainer for sticking the retainer on the human body.

Since claims 1,5, 13-18, 21-24, 27, and 32-35 have been provisionally rejected under the judicially created doctrine of obvious double patenting over claims 52-57, 59-68 and 73-74 under the **'641 application** in view of Hattori (U.S. Patent 4,553,550) applicant reserves the right to respond to this rejection on its merits should the **'641 application** ripen into an issued patent prior to the current case being allowed or in the alternative to file a terminal disclaimer relative to claims 1, 5, 13-18, 21, 27, and 32-35, should the **'641 application** ripen into an issued patent prior to the present application being allowed.

B U.S. Patent Application 10/454,236

Claims 1,5, 13-18, 21-24, 27, and 32-35 have been provisionally rejected on the judicially created doctrine of obvious double patenting over claims 52-57, 59-68 and 73-74 of copending Application Serial No.: 10/454,236 in view of Hattori (U.S. Patent 4,553,550).

U. S. Patent Application 10/454,236 hereinafter the **'236 application**, discloses a sporting activity aid comprised of a palm-shaped backing, another palm shaped secured to one side of the first mentioned palm-shaped backing by a layer of waterproof adhesive, a palm shaped pad adhesively secured to the other side of the first mentioned palm-shaped backing, and a skin compatible adhesive layer disposed on an opposite side of the another palm-shaped backing to facilitate removably securing the palm-shaped pad to the palm of a user.

Since claims 1,5, 13-18, 21-24, 27, and 32-35 have been provisionally rejected

under the judicially created doctrine of obvious double patenting over claims 52-57, 59-68 and 73-74 under the '**236 application**' in view of Hattori (U.S. Patent 4,553,550) applicant reserves the right to respond to this rejection on its merits should the '**236 application**' ripen into an issued patent prior to the current case being allowed or in the alternative to file a terminal disclaimer relative to claims 1, 5, 13-18, 21, 27, and 32-35, should the '**236 application**' ripen into an issued patent prior to the present application being allowed.

C. Rejections Under 35 USC §102(b)

Claims 1, 5, 13-18, 21 27 and 32-35 have been rejected under 35 USC §102(b), as being anticipated by Hattori (U.S. 4,553, 550)

Claim 1 as originally filed patentably distinguishes over Hattori (U.S. 4,553,550), hereinafter referred to as the **Hattori reference**. In this regard, claim 1 as amended specifies amongst other things, as follows:

1. A novelty fashion wear item, comprising:

a flexible pad having a planar body engaging surface and an attachment engaging surface;

wherein said attachment engaging surface is covered throughout with a layer of either hooks or piles; and

wherein said planar body engaging surface has fixed thereto a pair of flexible backings having different types of adhesives disposed thereon;

wherein one type of adhesive is a re-useable adhesive for removably securing said pad to a body part; and

wherein another type of adhesive is a waterproof adhesive for cooperating with said pair of backings to form a waterproof barrier between the skin of a user and the layer of either hooks or piles.

Nowhere is this combination of elements described in, nor suggested by the **Hattori reference**.

"Anticipation is established only when a single prior art reference discloses expressly or under the principles of inherency, each and every element of the claimed

invention." RCA Corp. v. Applied Digital Data Systems, Inc., (1984, CA FC) 221 U.S.P.Q. 385. The standard for lack of novelty that is for "anticipation," is one of strict identity. To anticipate a claim, a patent or a single prior art reference must contain all of the essential elements of the particular claims. Schroeder v. Owens-Corning Fiberglass Corp., 514 F.2d 901, 185 U.S.P.Q. 723 (9th Cir. 1975); and Cool-Fin Elecs. Corp. v. International Elec. Research Corp., 491 F.2d 660, 180 U.S.P.Q. 481 (9th Cir. 1974).

In the present Office Action, the Examiner's rejection is based on the **Hattori reference**, which fails to show all of the essential elements of the instant invention.

The **Hattori reference** describes a personal wearing article which comprises

- a) a garment having loops or hooks on an inner surface thereof;
- b) a retainer having hooks or loops on the front side thereof engageable with the loops and hooks on the garment; and
- c) a pressure sensitive agent layer provided on the backside of the retainer for sticking the retainer on the human body.

The novel features of the present invention are not disclosed, nor suggested by the **Hattori reference** in that the **Hattori reference** does not disclose, nor suggest "a pair of flexible backings having different types of adhesives disposed thereon..."

Secondly, the **Hattori reference** does not teach, nor suggest "wherein one type of adhesive is a re-useable adhesive for removably securing said pad to a body part".

Finally, the **Hattori reference** does not teach, nor suggest " wherein another type of adhesive is a water resistant adhesive for cooperating with said pair of flexible backings to form a waterproof barrier between the skin of a user and said layer of hooks and piles."

Thus, while the **Hattori reference** may teach a wearing apparel, the **Hattori reference** does not disclose, nor suggest, the novel features of the present invention as claimed. Therefore, claim 1 as amended, and its dependent claims 5, 13-18, and 21, patentably distinguish over the **Hattori reference**.

With reference to claims 32-35, claim 32 has been amended to make it more clear and definite, and which now provides:

32. (Currently Amended) A novelty fashion wear item, comprising:

a flexible pad having a top surface covered by a layered waterproof adhesive construction and a bottom surface at least partially covered with a layer of thistle cloth for providing said pad with a decorated textured finish; and

wherein said layered waterproof adhesive construction includes:

a first layer of a two sided acrylic pressure sensitive adhesive transfer tape attached to said top surface; and

a second layer of a polyurethane backing with one of its surfaces coated with an acrylate adhesive for fixing it to said first layer.

The novel features of the present invention are not disclosed, nor suggested by the **Hattori reference** in that the **Hattori reference** does not disclose, nor suggest “a layered waterproof adhesive construction”.

Secondly, the **Hattori reference** does not disclose nor teach, “a first layer of a two sided acrylic pressure sensitive adhesive transfer tape attached to said top surface....”

Finally, the **Hattori reference** does not teach, nor suggest, “a second layer of a polyurethane backing with one of its surfaces coated with an acrylate adhesive for fixing it to said first layer.”

Thus, while the **Hattori reference** may teach a wearing apparel, the **Hattori**

reference does not disclose, nor suggest, the novel features of the present invention as claimed. Therefore, claim 32 as amended, and its dependent claims 33-35, patentably distinguish over the **Hattori reference**.

Rejections Under 35 USC §103

A. Claims 26, 28, and 29 have been rejected under 35 U.S.C. §103 (a) over U.S. Patent No.: 4,553,550 issued to Hattori, hereinafter called the **Hattori reference**, in view of Larsson (U.S. 5,032,103), hereinafter called the **Larsson reference**. Applicant respectfully traverses these rejections for the following reasons:

The **Larsson reference** teaches a breast shield which is structured to be worn within the cup of a nursing brassiere, or under other clothing. See Col 2, lines 54-55. The breast shield has a rigid hemispherical dome shaped shell 15 and an elastic member 20. The shell is intended to be centered about the nipple of the breast and is preferably perforated for ventilation and air flow by a plurality of air holes.

Applicant respectfully asserts that the Examiner has not stated a proper *prima facie* case of obviousness in support of the rejections of claims 26, 28 and 29 for the following reasons: According to the Manual for Patent Examining Procedure (MPEP) § 2142, a proper *prima facie* case of obviousness can be established only when all of three basic criteria (“prongs”) are met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant’s disclosure. *In re Vaeck*, 947 F2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991).

In rejecting claim 26, 28 and 29 for alleged obviousness over the cited references, the examiner has not met the legal requirements cited in *In re Vaeck*, *supra* based on the following:

Regarding the first prong, the initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. The Examiner recites no evidence or suggestion for such combination from the prior art, despite the several motivating advantages of the combination discussed by Applicant in the present application. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure [*In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 9Fed. Cir. 1991). The level of skill in the art cannot be relied upon to provided the suggestion to combine references {*Al-Site Corp. V. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999)}. Thus, Applicant respectfully asserts that there is no suggestion from combining elements from *Hattori reference*, in view of the *Larsson reference* except by the use of hindsight relative to the disclosure from the present application. In fact, *Larsson reference* teaches a shell which directly engages the breast and because of this direct engagement the shell is provided with a series of perforations for air ventilation.

Claim 26 recites: a hard shell pre-formed cupped pad having a predefined shape for protecting a body part selected from a group consisting of at least one of the toes, knees, elbows, and animal pads; and wherein said hard shell preformed cupped pad has another layer of either hooks or piles for engaging at least a portion of either hooks or piles secured to said bottom surface. Neither *Hattori reference*, nor the *Larsson reference* consider or suggest such a combination; in fact, neither the *Hattori reference* nor the *Larsson reference* never discuss a protective hard shell for toes, knees, elbows, or let alone animal pads. Moreover, the *Larsson reference* teaches only a breast shield which is structure that resiliently spaces the shield from the nipple area so that it does not contact the nipple. Sell Col. 1, lines 62-65. Accordingly, the

Larsson reference teaches away from the combination as suggested by the examiner since the structure as taught by the **Hattori reference** would need to completely cover or at least cover a substantial portion of the breast to provide a sufficient supporting base to hold the hard shell protective shell as suggested by the examiner. Such a structure that would allow direct contact with the breast could cause chaffing and irritation. In conclusion then relative to the first prong, there is nothing presented by the examiner that would suggest or teach one skilled in the art to combine the cited references as suggest by the examiner except by reference to applicant's disclosure, which is not permitted under a U.S.C. 103(a) rejection. Accordingly, the present office action of February 2, 2006 does not support the first prong of a proper *prima facie* case of obviousness.

Regarding the second prong, Applicant can find no discussion of the likelihood of success (as found in the prior art) in the present office action of February 2, 2006 and therefore Applicant respectfully asserts that the office action does not support the second prong of a proper *prima facie* case of obviousness.

Regarding the third prong, the examiner has not cited any motivation set forth in cited references or in knowledge generally available to one of ordinary skilled in the art, to modify the structure of the cited prior art as proposed or suggested by the examiner. The examiner has simply made the conclusary statement that "it would have been obvious to have provided the adhesive pad of Hattori that is connectable to a breast covering by complimentary hooks or piles, since the adhesive pad of Hattori provided a hard shell pre-formed shaped breast covering would provide a pad that further protects the user from not only impact but sharp objects greatly protecting the user's breast below". In this regard, the Hattori reference is not concerned with protection of the covered body part, while the Larsson reference teaches away from enclosing the breast with a pad and specifically teaches providing a shield that resiliently spaces the shield from breast and the nipple area in particular which would not be possible by combining the references as suggested by the examiner.

Finally, it is to be noted that claims 26, 28 and 29 patentably distinguish over the Hattori reference in view of the Larsson reference because neither of the cited references whether taken alone or in combination with one another does not teach nor suggest, “a flexible pad having a planar body engaging surface and an attachment engaging surface...wherein said planar body engaging surface has fixed thereto a pair of flexible backings having different types of adhesives disposed thereon”

Finally, neither the Hattori reference nor the Larsson reference, whether taken alone or in combination with one another does not disclose nor teach, “wherein another type of adhesive is a waterproof adhesive for cooperating with said pair of backings to form a waterproof barrier between the skin of a user and said layer of either hooks or piles.” Such a layered waterproof adhesive construction is clearly not taught by either the *Hattori reference* or the *Larsson reference* or any other cited reference of record.

Claims 28 and 29 also distinguish over the cited references of record under the same rationale as set forth above relative to claim 26. More specifically however, it should be noted that the *Larsson reference* in particular teaches away from the claimed invention, since the *Larsson reference* specifically teaches that “direct contact on the breast and on the nipples, in particular, can itself cause chaffing and irritation...” Accordingly, to cover the breast or the breast and nipple with a retainer as taught the *Hattori reference*, would not be considered as this construction would cause chaffing and irritation. It is for this reason, the *Larsson reference* teaches away from providing a retainer that would directly contact the breast. More specifically, *the Larsson reference* teaches that “The elastic member 20, when extended across the open bottom of the shell 15, serves as a base or mount for the shell 15 that resiliently spaces the shell 15 from directly contacting ...the breast. ...The breast shield 10 is held in place by the pressure of the brassiere or other fitted garment.” (See column 4, lines 10-20).

For the foregoing reasons, withdrawal of the obviousness rejection of claim 26, 28 and 29 over the combination of the cited prior art is requested.

B Claims 22-24 have been rejected under 35 U.S.C. §103 (a) over U.S. Patent No.: 4,553,550 issued to Hattori, hereinafter called the **Hattori reference**, in view of Mower (U.S. 3,092,103), hereinafter called the **Mower reference**. Applicant respectfully traverses these rejections for the following reasons:

The **Mower reference** teaches an eye patch for attachment to the face of a user over an afflicted or injured eye to cushion the eye from shock. The eye patch generally includes a cover (1) having a generally oval shaped center portion in keeping with the general shape of a human eye socket. The cover (1) is made of a soft flexible material which rests on top of a thicker layer or sheet (2) of cushioning material which has a relatively large oval shaped aperture (3). The cushioning material (2) defines a marginal wall beneath the oval portion of the cover (1). The cushioning materials are sufficiently thick so that when the patch is secured over the eye, the eye may freely be opened and closed, and naturally nictitate beneath the cover (1) and without interference from the cover (1). The cushioning material (2) is secured to the undersurface of the cover (1) by an adhesive (4) which does not extend over the portion of the cover closing the opening (3) in the cushioning material (2). The undersurface of the cushioning material (2) carries an adhesive spread of the pressure sensitive type for attaching the patch to the face of the user, where the adhesive spread is a thin plastic film (5) which is double faced with adhesive indicated generally at 6 and 7.

Applicant respectfully asserts that the examiner has not stated a proper *prima facie* case of obviousness in support of the rejections of claims 22-24 for the following reasons. According to the Manual for Patent Examining Procedure (MPEP) § 2142, a proper *prima facie* case of obviousness can be established only when all of three basic criteria ("prongs") are met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary

skilled in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. ***In re Vaeck, 947 F2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991).***

In rejecting claim 22-24 for alleged obviousness over the ***Hattori reference*** in view of the ***Mower reference***, the examiner has not met the legal requirements cited in ***In re Vaeck, supra*** based on the following:

Regarding the first prong, the initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. The examiner recites no evidence or suggestion for using the adhesive pad as described in the ***Hattori reference*** with the eye patch as taught by the ***Mower reference***. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure [In re Vaeck, 947 F.2d 488, 20 USPQ 2d 1438 9Fed. Cir. 1991). The level of skill in the art cannot be relied upon to provide the suggestion to combine references {Al-Site Corp. V. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir.1999)}. Thus Applicant respectfully asserts that there is no suggestion from combining elements from the ***Hattori reference*** with the ***Mower reference*** even in the present application. Accordingly, the present office action of citing ***Mower reference*** does not support the first prong of a proper *prima facie* case of obviousness.

Regarding the second prong, Applicant can find no discussion of the likelihood of success (as found in the prior art) in the present office action of February 2, 2006 and therefore Applicant respectfully asserts that the office action does not support the second prong for a proper *prima facie* case of obviousness.

Regarding the third prong, the examiner has not cited any motivation set forth in the **Hattori reference** nor the **Mower reference** nor in knowledge generally available to one of ordinary skill in the art, to modify the **Hattori reference** with the layered tape structure of the **Mower reference** as proposed or suggested by the examiner. The examiner has simply made the conclusory statement that the number of layers of adhesive are irrelevant coupled with the statement that it would have been obvious to provide the adhesive on a transfer tape as long as “the adhesive secures that transfer tape to the pad body and to the waterproof film.”

Finally, applicant further traverses the rejection because claim 22-24 as amended patentably distinguish over the Hattori reference and the **Mower reference** whether taken alone or in combination with one another because claim 22 as amended emphasizes the novel features of the present invention. In this regard, claim 22, as amended now specifies:

22. (Currently Amended) The novelty fashion wear item according to claim 1, wherein one of said pair of backings is a two sided acrylic pressure sensitive adhesive transfer tape attached to said body engaging surface; and

wherein the other one of said pair of backings is a polyurethane backing with one of its surfaces coated with a water resistant acrylate adhesive for fixing it to said two sided acrylic pressure sensitive transfer tape.

The novel features and steps of the present invention are not disclosed, nor suggested by the **Hattori reference** in view of the **Mower reference** in that neither the **Hattori reference** nor the **Mower reference** whether taken alone or in combination with one another disclose or teach, “wherein the other one of said pair of backings is a polyurethane backing with one of its surfaces coated with a water resistant acrylate adhesive for fixing it to said two sided acrylic pressure sensitive transfer tape.”

Instead, the **Hattori reference** is completely silent relative to such a structure while the **Mower reference** teaches, “a thin plastic film 5 which is double-faced with

adhesive as indicated at 6 and 7.” for covering an eye socket. In this regard, the **Mower reference** teaches only a single two-side pressure sensitive transfer tape instead of “ a pair of backing”.

Finally, neither the **Hattori reference** nor the **Mower reference** teach or suggest, “wherein ...one of said pair of backings is a polyurethane backing with one of its surfaces coated with a water resistant acrylate adhesive for fixing it to said two sided acrylic pressure sensitive transfer tape.” In this regard, both the **Hattori reference** and the **Mower reference** are again completely silent relative to a second backing which is “coated with a water resistant acrylate adhesive.”

Thus, while the cited references may teach a flexible sheet of eye patch material with a hole, the cited references whether taken alone or in combination with one another does not disclose, nor suggest, the novel features of the present invention as claimed. Therefore Claim 22 as amended patentably distinguishes over the **Hattori reference** in view of the **Mower reference**.

With reference to Claim 23, the examiner has stated that the **Hattori reference** fails to teach the layered waterproof adhesive construction but the **Mower reference** teaches, “an adhesive that is capable of being reused” and that the waterproof layer pad of Mower would also inherently be a sweat barrier.” Applicant respectfully disagrees with the examiner on the following grounds:

Claim 23 as amended now specifies:

23. (Currently Amended) The novelty fashion wear item according to claim 1, wherein said pair of flexible backings are fixed together by a waterproof acrylate adhesive to facilitate formation of said waterproof barrier.

Based on the foregoing, claim 23 patentably distinguishes over the cited

references whether taken alone or in combination with one another under the same rationale as set forth for claim 22. That is, both the **Hattori reference** and the **Mower reference** fail to teach or suggest “a pair of flexible backings having different types of adhesive disposed thereon” where the “flexible backings are fixed together by a waterproof acrylate adhesive to facilitate formation of said waterproof barrier.”

Applicant also traverses the rejection of claim 24 because claim 24 as amended patentably distinguish over the **Hattori reference** and the **Mower reference** whether taken alone or in combination with one another because claim 24 as amended emphasizes the novel features of the present invention. In this regard, claim 24, as amended now specifies:

24. (Currently Amended) The novelty fashion wear item according to claim 1, wherein said pair of flexible backings having different types of adhesives disposed thereon blocks sweat includes:

a strip of polyurethane tape having a pad facing surface and a body part facing surface, said body part facing surface being coated with a layer of waterproof adhesive and said pad facing surface being coated with another layer of waterproof adhesive for securing said strip of polyurethane tape to said body engaging surface; and

another strip of polyurethane tape having another pad facing surface and another body part facing surface;

wherein said another body part facing surface is coated with said skin compatible reusable adhesive layer for facilitating removably securing said pad to said user selected body part; and

wherein said strip of polyurethane tape and said another strip of polyurethane tape are secured to one another by said layer of the waterproof adhesive disposed on said body part facing surface of said strip of polyurethane tape.

In rejecting claim 24, the examiner has stated: “Mower reference teaches an adhesive that is capable of being reused. The layered adhesive means that is waterproof (see figure 3). A two pressure sensitive adhesive transfer tape attached to the body engaging surface and a waterproof film backing with one of its surfaces

coated with a achieve [sic] to affix to the transfer tape (column2, lines 36-52). Further, the backing of Mover has an adhesive to be compatible with a user's skin (column 2, lines 64-69). Attorney for applicant asserts that the examiner has mischaracterized what is taught by the Mower reference on the following grounds:

The Mower reference at column 2, lines 36-52 provides the following:

"The underface of the cushioning material 2 carries an adhesive spread, preferably of the pressure-sensitive type, by means of which the patch is attached to the face of the user. This adhesive spread may be provided in substantially any suitable manner, a very satisfactory way being to utilize a thin plastic film 5 which is double-faced with adhesive as indicated at 6 and 7. Such film may be secured to the underside of the cushioning material 2 by adhesive face 6, leaving the opposite adhesive face 7 exposed for use on the body. The film may satisfactorily be an acetate film, a vinyl film, and a polyester film such as that made from a polyethylene terephthalate resin has proven satisfactory, particularly because of its outstanding strength and because it can be made extremely thin, this particular material being obtainable in various thicknesses from 0.00025 to .00075 inch."

From the foregoing it is clear that the Mower reference does not teach nor disclose a "pair of flexible backings having different types of adhesives disposed thereon" since the Mower reference teaches only a single strip of plastic film which is double-faced with adhesive on each side of the film.

Based on the foregoing, claim 24 patentably distinguishes over the cited references whether taken alone or in combination with one another under the same rationale as set forth for claim 22. That is, both the *Hattori reference* and the *Mower reference* fail to teach or suggest "a pair of flexible backings."

Drawing Amendment

Applicant respectfully requests that FIG. 18 be amended so that it corresponds to the specification. In this regard, the specification provides at paragraph 0028 "a two-sided acrylic pressure sensitive transfer tape 17 on the top surface 12, and a layer of

MSX 5527 acrylate adhesive 14 (a polyurethane backing with acrylate adhesive may be obtained from 3M Healthcare as MSX5527 acrylate polyurethane 1.2 mil tape), and a peel sheet 18 protecting the adhesive until ready to use.” In addition, at paragraph 0032, it provides, “the adhesive selected should be of sufficient strength to hold pad 10 onto the bottom of foot 1...It is desirable that the adhesive selected be waterproof as well as compatible with the skin of the bottom of the foot.

Finally with reference to FIG. 18 four distinct and separate elements can be seen in the following order: a pad (10) having a bottom surface (13) and a top surface (12); a transfer tape (17) composed of a polyurethane backing sandwiched between two layers of pressure sensitive adhesive; a polyurethane backing supporting an acrylate adhesive (14); and a peel sheet (18).

In further support for this amendment to FIG. 18, applicant has previously provided a Rule 132 declaration which includes data sheets for the above described transfer tapes and adhesives.

In view of the foregoing, applicant respectfully requests that the red-lined drawing of FIG. 18 be approved and that the clean copy of FIG. 18 as amended be entered and allowed.



Conclusion

Attorney for Applicant has carefully reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Jerry R. Potts, Esq. at the below-listed telephone number.

Dated: April 29, 2006

Respectfully submitted,

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By

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